



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

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Washington, D.C. 20231

AS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/525, 176 03/14/00 VASILEIADIS

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IM52/1108

EXAMINER

SAVVAS VASILEIADIS  
ZIVATECH  
15549 DEARBORN STREET  
NORTH HILLS CA 91343-3267

VANDY, T

ART UNIT

PAPER NUMBER

1754

4

DATE MAILED:

11/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. 09-525,176	Applicant(s) <b>VASILEIADIS</b>
	Examiner <b>VANOY</b>	Group Art Unit <b>1754</b>

**—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ZERO MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

Responsive to communication(s) filed on dated SEPT. 18, 2001

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

Claim(s) ORIGINAL CLAIMS 1-45

are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

is/are allowed.

is/are rejected.

is/are objected to.

are subject to restriction or election requirement

**Application Papers**

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

All  Some\*  None of the:

Certified copies of the priority documents have been received.

Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

**Attachment(s)**

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892

Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948

Other COPIES OF SELECTED

PORTIONS OF SECTIONS  
608.01; 608.01(g) AND 714 FROM  
THE M.P.E.P.

**Office Action Summary**

Part of Paper No. 4



## UNITED STATES DEPARTMENT OF COMMERCE

## Patent and Trademark Office

Address: ASSISTANT COMMISSIONER FOR PATENTS

Washington, D.C. 20231

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT

PAPER

4

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

The Applicants have responded to the Written Restriction Requirement mailed on 08/21/01 by submitting a substitute specification dated Sept. 18, 2001, however the Applicants' Response is in error because amendments to claims do not require the submission of a substitute specification. The Applicants' attention is directed to the criteria for amending claims required by 37 CFR 1.121 described in section 714 in the Manual of Patent Examining Procedure (8<sup>th</sup> ed., Aug. 2001). Note that amendments to claims require: (1) a clean version of the amended (replacement) paragraph(s)/claim(s); (2) a marked-up version (also on a separate sheet of paper) showing the changes and clearly identified as "Version with markings to show changes made", and (3) a remarks section (beginning on a separate sheet of paper).

A substitute specification is required because the lines in both the original specification and the substitute specification submitted with the Applicants' Response dated Sept. 18, 2001 are single spaced, instead of double spaced. Also, it is helpful if the lines of the specification were numerated: please see the section 608.01 in the Manual of Patent Examining Procedure (8<sup>th</sup> ed., Aug. 2001) and note the criteria for specifications set forth in 37 CFR 1.71 and 37 CFR 1.52 contained therein. The Applicants should carefully review the criteria and requirements for substitute specifications set forth in section 608.01(q) in the Manual of Patent Examining Procedure (8<sup>th</sup> ed., Aug. 2001).

The Applicants' Response dated Sept. 18, 2001 has been placed in the file, but has not been entered, and the original specification and original claims are still pending before the Patent Office. The "marked up" copy of the claims and the "marked up" copy of the original specification should reflect changes made to the original specification and claims (not the specification and claims submitted with the Applicants' Response dated Sept. 18, 2001).

An examination of this application reveals that the Applicants are unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. The Applicants are advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution. The Patent Office cannot aid in selecting an attorney or agent.

The Applicants are advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

A shortened statutory period for reply is set to expire 30 (thirty) days from the mailing date of this communication. Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after 6 (six) months from the mailing date of this communication.

Failure to reply within the set or extended period for reply will, by statute, cause the application to become abandoned (35 USC 133).

Any inquiry concerning this communication of earlier communications from the Examiner should be directed to Timothy Vanoy whose phone number is 703-308-2540. The Supervisory Patent Examiner for Art Unit 1754 is Steve Griffen whose phone number is 703-308-1164. The fax numbers for Tech Center 1700 are: 703-873-9311 for communications submitted after a Final Office Action, and 703-872-9310 for communications submitted before a Final Office Action.

Timothy Vanoy/tv  
Nov. 5, 2001

*Timothy Vanoy*  
Timothy Vanoy  
Patent Examiner  
Art Unit 1754

enclosures: copies of selected portions from sections 608.01(q); 608.01 and 714 from the M.P.E.P. (8<sup>th</sup> ed., Aug. 2001).

ple, in the following types of situations: (1) a deposit account charged for an extension of time pursuant to 37 CFR 1.136(a)(3) as a result of there being a prior general authorization in the application; or (2) a deposit account charged for the outstanding balance of a fee as a result of an insufficient fee submitted with an authorization to charge the deposit account for any additional fees that are due. In these situations, the party providing the charge authorization is not in a position to know the exact amount by which the deposit account will be charged until the date of the deposit account statement indicating the amount of the charge. Therefore, the two-year time period set forth in 37 CFR 1.26(b) does not begin until the date of the deposit account statement indicating the amount of the charge.

#### LATER ESTABLISHMENT OF SMALL ENTITY STATUS

Effective November 7, 2000, 37 CFR 1.28(a) was amended to provide a three-month period (instead of the former two-month period) for requesting a refund based on later establishment of small entity status. As the Office now treats the receipt date of a deposit account charge authorization as the fee payment date (for refund purposes), any request for a refund under 37 CFR 1.28(a) must be made within three months from the date the charge authorization is received in the Office.

#### 608 Disclosure

In return for a patent, the inventor gives as consideration a complete revelation or disclosure of the invention for which protection is sought. All amendments or claims must find descriptive basis in the original disclosure, or they involve new matter. Applicant may rely for disclosure upon the specification with original claims and drawings, as filed. See also 37 CFR 1.121, subsections (a)(6) and (b)(2)(iii) and MPEP § 608.04.

If during the course of examination of a patent application, an examiner notes the use of language that could be deemed offensive to any race, religion, sex, ethnic group, or nationality, he or she should object to the use of the language as failing to comply with the Rules of Practice. 37 CFR 1.3 proscribes the presentation of papers which are lacking in decorum and courtesy. There is a further basis for objection in

that the inclusion of such proscribed language in a Federal Government publication would not be in the public interest. Also, the inclusion in application drawings of any depictions or caricatures that might reasonably be considered offensive to any group should be similarly objected to, on like authority.

The examiner should not pass the application to issue until such language or drawings have been deleted, or questions relating to the propriety thereof fully resolved.

For design application practice, see MPEP § 1504.

#### 608.01 Specification

##### *35 U.S.C. 22. Printing of papers filed.*

The Director may require papers filed in the Patent and Trademark Office to be printed, typewritten, or on an electronic medium.

##### *37 CFR 1.71. Detailed description and specification of the invention.*

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

(d) A copyright or mask work notice may be placed in a design or utility patent application adjacent to copyright and mask work material contained therein. The notice may appear at any appropriate portion of the patent application disclosure. For notices in drawings, see § 1.84(o). The content of the notice must be limited to only those elements required by law. For example, "© 1983 John Doe" (17 U.S.C. 401) and "M John Doe" (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in paragraph (e) of this section is included at the beginning (preferably as the first paragraph) of the specification.

## (e) The authorization shall read as follows:

A portion of the disclosure of this patent document contains material which is subject to {copyright or mask work} protection. The {copyright or mask work} owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records, but otherwise reserves all {copyright or mask work} rights whatsoever.

The specification is a written description of the invention and of the manner and process of making and using the same. The specification must be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention pertains to make and use the same. See 35 U.S.C. 112 and 37 CFR 1.71. If a newly filed application obviously fails to disclose an invention with the clarity required by 35 U.S.C. 112, revision of the application should be required. See MPEP § 702.01.

The specification does not require a date.

Certain cross notes to other related applications may be made. References to foreign applications or to applications identified only by the attorney's docket number should be required to be canceled. See 37 CFR 1.78 and MPEP § 202.01.

As the specification is never returned to applicant under any circumstances, the applicant should retain a line for line copy thereof, each line, preferably, having been consecutively numbered on each page. In amending, the attorney or the applicant requests insertions, cancellations, or alterations, giving the page and the line.

Form paragraph 7.29 may be used where the disclosure contains minor informalities.

**¶ 7.29 Disclosure Objected to, Minor Informalities**

The disclosure is objected to because of the following informalities: [1]. Appropriate correction is required.

**Examiner Note:**

Use this paragraph to point out minor informalities such as spelling errors, inconsistent terminology, numbering of elements, etc., which should be corrected. See form paragraphs 6.28 to 6.32 for specific informalities.

Form paragraphs 6.29-6.31 should be used where appropriate.

**¶ 6.29 Specification, Spacing of Lines**

The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application

papers with lines double spaced on good quality paper are required.

**¶ 6.30 Numerous Errors in Specification**

35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: [1].

**¶ 6.31 Lengthy Specification, Jumbo Application**

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

**Examiner Note:**

This paragraph is applicable in so-called "Jumbo Applications" (more than 20 pages, exclusive of claims).

**PAPER REQUIREMENTS****37 CFR 1.52. Language, paper, writing, margins, compact disc specifications.**

(a) Papers that are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or a reexamination proceeding.

(1) All papers, other than drawings, that are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding must be on sheets of paper that are the same size, and:

(i) Flexible, strong, smooth, non-shiny, durable, and white;

(ii) Either 21.0 cm by 29.7 cm (DIN size A4) or 21.6 cm by 27.9 cm (8 1/2 by 11 inches), with each sheet including a top margin of at least 2.0 cm (3/4 inch), a left side margin of at least 2.5 cm (1 inch), a right side margin of at least 2.0 cm (3/4 inch), and a bottom margin of at least 2.0 cm (3/4 inch);

(iii) Written on only one side in portrait orientation;

(iv) Plainly and legibly written either by a typewriter or machine printer in permanent dark ink or its equivalent; and

(v) Presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition.

(2) All papers that are to become a part of the permanent records of the United States Patent and Trademark Office should have no holes in the sheets as submitted.

(3) The provisions of this paragraph and paragraph (b) of this section do not apply to the pre-printed information on forms provided by the Office, or to the copy of the patent submit-

ted in double column format as the specification in a reissue application or request for reexamination.

(4) See § 1.58 for chemical and mathematical formulae and tables, and § 1.84 for drawings.

(5) If papers that do not comply with paragraph (a)(1) of this section are submitted as part of the permanent record, other than the drawings, applicant, or the patent owner, or the requester in a reexamination proceeding, will be notified and must provide substitute papers that comply with paragraph (a)(1) of this section within a set time period.

(b) The application (specification, including the claims, drawings, and oath or declaration) or reexamination proceeding and any amendments or corrections to the application or reexamination proceeding.

(1) The application or proceeding and any amendments or corrections to the application (including any translation submitted pursuant to paragraph (d) of this section) or proceeding, except as provided for in § 1.69 and paragraph (d) of this section, must:

(i) Comply with the requirements of paragraph (a) of this section; and

(ii) Be in the English language or be accompanied by a translation of the application and a translation of any corrections or amendments into the English language together with a statement that the translation is accurate.

(2) The specification (including the abstract and claims) for other than reissue applications and reexamination proceedings, and any amendments for applications (including reissue applications) and reexamination proceedings to the specification, except as provided for in §§ 1.821 through 1.825, must have:

(i) Lines that are 1 1/2 or double spaced;

(ii) Text written in a nonscript type font (e.g., Arial, Times Roman, or Courier) lettering style having capital letters which are at least 0.21 cm (0.08 inch) high; and

(iii) Only a single column of text.

(3) The claim or claims must commence on a separate sheet (§ 1.75(h)).

(4) The abstract must commence on a separate sheet or be submitted as the first page of the patent in a reissue application or reexamination proceeding (§ 1.72(b)).

(5) Other than in a reissue application or reexamination proceeding, the pages of the specification including claims and abstract must be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text.

(6) Other than in a reissue application or reexamination proceeding, the paragraphs of the specification, other than in the claims or abstract, may be numbered at the time the application is filed, and should be individually and consecutively numbered using Arabic numerals, so as to unambiguously identify each paragraph. The number should consist of at least four numerals enclosed in square brackets, including leading zeros (e.g., [0001]).

The numbers and enclosing brackets should appear to the right of the left margin as the first item in each paragraph, before the first word of the paragraph, and should be highlighted in bold. A gap, equivalent to approximately four spaces, should follow the number. Nontext elements (e.g., tables, mathematical or chemical formulae, chemical structures, and sequence data) are considered part of the numbered paragraph around or above the elements, and should not be independently numbered. If a nontext element extends to the left margin, it should not be numbered as a separate and independent paragraph. A list is also treated as part of the paragraph around or above the list, and should not be independently numbered. Paragraph or section headers (titles), whether abutting the left margin or centered on the page, are not considered paragraphs and should not be numbered.

(7) If papers that do not comply with paragraphs (b)(1) through (b)(5) of this section are submitted as part of the application, applicant, or patent owner, or requester in a reexamination proceeding, will be notified and the applicant, patent owner or requester in a reexamination proceeding must provide substitute papers that comply with paragraphs (b)(1) through (b)(5) of this section within a set time period.

(c)(1) Any interlineation, erasure, cancellation or other alteration of the application papers filed must be made before the signing of any accompanying oath or declaration pursuant to § 1.63 referring to those application papers and should be dated and initialed or signed by the applicant on the same sheet of paper. Application papers containing alterations made after the signing of an oath or declaration referring to those application papers must be supported by a supplemental oath or declaration under § 1.67. In either situation, a substitute specification (§ 1.125) is required if the application papers do not comply with paragraphs (a) and (b) of this section.

(2) After the signing of the oath or declaration referring to the application papers, amendments may only be made in the manner provided by § 1.121.

(3) Notwithstanding the provisions of this paragraph, if an oath or declaration is a copy of the oath or declaration from a prior application, the application for which such copy is submitted may contain alterations that do not introduce matter that would have been new matter in the prior application.

(d) A nonprovisional or provisional application may be in a language other than English.

(1) Nonprovisional application. If a nonprovisional application is filed in a language other than English, an English language translation of the non-English language application, a statement that the translation is accurate, and the processing fee set forth in § 1.17(i) are required. If these items are not filed with the application, applicant will be notified and given a period of time within which they must be filed in order to avoid abandonment.

(2) Provisional application. If a provisional application is filed in a language other than English, an English language translation of the non-English language provisional application will not be required in the provisional application. See § 1.78(a) for the requirements for claiming the benefit of such provisional application in a nonprovisional application.

## MANUAL OF PATENT EXAMINING PROCEDURE

(e) Electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding.

(1) The following documents may be submitted to the Office on a compact disc in compliance with this paragraph:

- (i) A computer program listing (see § 1.96);
- (ii) A "Sequence Listing" (submitted under § 1.821(c)); or
- (iii) A table (see § 1.58) that has more than 50 pages of text.

(2) A compact disc as used in this part means a Compact Disc-Read Only Memory (CD-ROM) or a Compact Disc-Recordable (CD-R) in compliance with this paragraph. A CD-ROM is a "read-only" medium on which the data is pressed into the disc so that it cannot be changed or erased. A CD-R is a "write once" medium on which once the data is recorded, it is permanent and cannot be changed or erased.

(3)(i) Each compact disc must conform to the International Standards Organization (ISO) 9660 standard, and the contents of each compact disc must be in compliance with the American Standard Code for Information Interchange (ASCII).

(ii) Each compact disc must be enclosed in a hard compact disc case within an unsealed padded and protective mailing envelope and accompanied by a transmittal letter on paper in accordance with paragraph (a) of this section. The transmittal letter must list for each compact disc the machine format (e.g., IBM-PC, Macintosh), the operating system compatibility (e.g., MS-DOS, MS-Windows, Macintosh, Unix), a list of files contained on the compact disc including their names, sizes in bytes, and dates of creation, plus any other special information that is necessary to identify, maintain, and interpret the information on the compact disc. Compact discs submitted to the Office will not be returned to the applicant.

(4) Any compact disc must be submitted in duplicate unless it contains only the "Sequence Listing" in computer readable form required by § 1.821(e). The compact disc and duplicate copy must be labeled "Copy 1" and "Copy 2," respectively. The transmittal letter which accompanies the compact disc must include a statement that the two compact discs are identical. In the event that the two compact discs are not identical, the Office will use the compact disc labeled "Copy 1" for further processing. Any amendment to the information on a compact disc must be by way of a replacement compact disc in compliance with this paragraph containing the substitute information, and must be accompanied by a statement that the replacement compact disc contains no new matter. The compact disc and copy must be labeled "COPY 1 REPLACEMENT MM/DD/YYYY" (with the month, day and year of creation indicated), and "COPY 2 REPLACEMENT MM/DD/YYYY," respectively.

(5) The specification must contain an incorporation-by-reference of the material on the compact disc in a separate paragraph (§ 1.77(b)(4)), identifying each compact disc by the names of the files contained on each of the compact discs, their date of creation and their sizes in bytes. The Office may require

applicant to amend the specification to include in the paper portion any part of the specification previously submitted on compact disc.

(6) A compact disc must also be labeled with the following information:

- (i) The name of each inventor (if known);
- (ii) Title of the invention;
- (iii) The docket number, or application number if known, used by the person filing the application to identify the application; and
- (iv) A creation date of the compact disc.
- (v) If multiple compact discs are submitted, the label shall indicate their order (e.g. "1 of X").
- (vi) An indication that the disk is "Copy 1" or "Copy 2" of the submission. See paragraph (b)(4) of this section.

(7) If a file is unreadable on both copies of the disc, the unreadable file will be treated as not having been submitted. A file is unreadable if, for example, it is of a format that does not comply with the requirements of paragraph (e)(3) of this section, it is corrupted by a computer virus, or it is written onto a defective compact disc.

*37 CFR 1.58. Chemical and mathematical formulae and tables.*

(a) The specification, including the claims, may contain chemical and mathematical formulas, but shall not contain drawings or flow diagrams. The description portion of the specification may contain tables; claims may contain tables either if necessary to conform to 35 U.S.C. 112 or if otherwise found to be desirable.

(b) Tables that are submitted in electronic form (§§ 1.96(c) and 1.821(c)) must maintain the spatial relationships (e.g., columns and rows) of the table elements and preserve the information they convey. Chemical and mathematical formulae must be encoded to maintain the proper positioning of their characters when displayed in order to preserve their intended meaning.

(c) Chemical and mathematical formulae and tables must be presented in compliance with § 1.52(a) and (b), except that chemical and mathematical formulae or tables may be placed in a landscape orientation if they cannot be presented satisfactorily in a portrait orientation. Typewritten characters used in such formulae and tables must be chosen from a block (nonscript) type font or lettering style having capital letters which are at least 0.21 cm. (0.08 inch) high (e.g., elite type). A space at least 0.64 cm. (1/4 inch) high should be provided between complex formulae and tables and the text. Tables should have the lines and columns of data closely spaced to conserve space, consistent with a high degree of legibility.

The pages of the specification including claims and abstract must be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text. The lines of the specification, and any amendments to the specification, must be 1 1/2 or double spaced.

All application papers (specification, including claims, abstract, any drawings, oath or declaration, and other papers), and also papers subsequently filed, must have each page plainly written on only one side of a sheet of paper. The claim or claims must commence on a separate sheet (37 CFR 1.75(h)) and the abstract must commence on a separate sheet (37 CFR 1.72(b)).

All application papers which are to become a part of the permanent record of the U.S. Patent and Trademark Office must be on sheets of paper which are the same size and are either 21.0 cm. by 29.7 cm. (DIN size A4) or 21.6 cm. by 27.9 cm. (8 1/2 by 11 inches). See 37 CFR 1.52(a)(1) and 37 CFR 1.84(f). Each sheet, other than the drawings, must include a top margin of at least 2.0 cm. (3/4 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 2.0 cm. (3/4 inch), and a bottom margin of at least 2.0 cm. (3/4 inch). No holes should be made in the sheets as submitted.

Applicants must make every effort to file patent applications in a form that is clear and reproducible. If the papers are not of the required quality, substitute typewritten or mechanically printed papers of suitable quality will be required. See 37 CFR 1.125 for filing substitute typewritten or mechanically printed papers constituting a substitute specification required by the Office. See also MPEP § 608.01(q). All papers which are to become a part of the permanent records of the U.S. Patent and Trademark Office must be legibly written either by a typewriter or mechanical printer in permanent dark ink or its equivalent in portrait orientation on flexible, strong, smooth, nonshiny, durable, and white paper. Typed, mimeographed, xeroprinted, multigraphed or nonsmearing carbon copy forms of reproduction are acceptable.

Where an application is filed with papers that do not comply with 37 CFR 1.52, the Office of Initial Patent Examination will mail a "Notice to File Corrected Application Papers" (PTO 1660) indicating the deficiency and setting a time period within which the applicant must correct the deficiencies to avoid abandonment. The failure to submit application papers in compliance with 37 CFR 1.52 does not effect the grant of a filing date, and original application papers that do not comply with 37 CFR 1.52 will be retained in the application file as the original disclosure of the

invention. The USPTO will not return papers simply because they do not comply with 37 CFR 1.52.

Legibility includes ability to be photocopied and photomicrographed so that suitable reprints can be made and ability to be electronically reproduced by use of digital imaging and optical character recognition. This requires a high contrast, with black lines and a white background. Gray lines and/or a gray background sharply reduce photo reproduction quality. Legibility of some application papers may become impaired due to abrasion or aging of the printed material during examination and ordinary handling of the file. It may be necessary to require that legible and permanent copies be furnished at later stages after filing, particularly when preparing for issue.

Some of the patent application papers received by the U.S. Patent and Trademark Office are copies of the original, ribbon copy. These are acceptable if, in the opinion of the Office, they are legible and permanent.

The paper used must have a surface such that amendments may be written thereon in ink. So-called "Easily Erasable" paper having a special coating so that erasures can be made more easily may not provide a "permanent" copy, 37 CFR 1.52(a)(1)(iv). If a light pressure of an ordinary (pencil) eraser removes the imprint, the examiner should, as soon as this becomes evident, notify applicant by use of Form paragraph 6.32 that it will be necessary for applicant to order a copy of the specification and claims to be made by the U.S. Patent and Trademark Office at the applicant's expense for incorporation in the file. It is not necessary to return this copy to applicant for signature.

#### *¶ 6.32 Application on Easily Erasable Paper or Erasable Ink*

The application papers are objected to because they are not a permanent copy as required by 37 CFR 1.52(a)(1)(iv). Reference is made to [1].

Applicant is required either (1) to submit permanent copies of the identified parts or (2) to order a photocopy of the above identified parts to be made by the U.S. Patent and Trademark Office at applicant's expense for incorporation in the file. See MPEP § 608.01.

#### **Examiner Note:**

In the bracket, identify: 1) all of the specification; 2) certain pages of the specification; 3) particular claim(s); 4) the oath or declaration; 5) etc.

<sup>1</sup>See *In re Benson*, 1959 C.D. 5, 744 O.G. 353 (Comm'r Pat. 1959). Reproductions prepared by heat-sensitive, hectographic, or spirit duplication processes are also not satisfactory.

### ALTERATION OF APPLICATION PAPERS

37 CFR 1.52(c) relating to interlineations and other alterations is strictly enforced. See *In re Swanberg*, 129 USPQ 364 (Comm'r Pat. 1960). See also MPEP § 605.04(a).

### CERTIFIED COPIES OF AN APPLICATION-AS-FILED

If an application-as-filed does not meet the sheet size/margin and quality requirements of 37 CFR 1.52 and 1.84(f) and (g), certified copies of such application may be illegible and/or ineffective as priority documents. When an applicant requests that the USPTO provide a certified copy of an application-as-filed and pays the fee set forth in 37 CFR 1.19(b)(1), the USPTO will make a copy of the application-as-filed from the records in the Patent Image Capturing System (PICS) database (or the microfilm database). If papers submitted in the application-as-filed are not legible, certified copies of the application as originally filed will not be legible.

The USPTO performs exception processing when scanning application papers that do not comply with the sheet size/margin and quality requirements. If papers submitted in the application-as-filed (including any transmittal letter or cover sheet) do not meet the sheet size requirement of 37 CFR 1.52 and 1.84(f) (e.g., the papers are legal size (8 1/2 by 14 inches)), the USPTO must reduce such papers to be able to image-scan the entire application and record it in the PICS database. In addition, if papers submitted in the application-as-filed do not meet the quality requirements of 37 CFR 1.52 (e.g., the papers are shiny or non-white), the USPTO will attempt to enhance such papers before scanning to make the resulting electronic record in the PICS database more readable. However, if exception processing is required to make the PICS copy, certified copies of the application as originally filed may not be legible.

If application papers are filed that do not meet sheet size/margin and quality requirements, the

USPTO will require the applicant to file substitute papers that do comply with the requirements of 37 CFR 1.52 and 1.84(f) and (g). The substitute papers submitted in reply to the above-mentioned requirement will provide the USPTO with an image- and OCR-scannable copy of the application for printing the application as a patent. However, the USPTO will not treat application papers submitted after the filing date of an application as the original disclosure of the application for making a certified copy of the application-as-filed or any other purpose. That is, even if an applicant subsequently files substitute application papers that comply with 37 CFR 1.52 and then requests that the USPTO provide a certified copy of an application-as-filed, paying the fee set forth in 37 CFR 1.19(b)(1), the USPTO will still make a copy of the application-as-filed from the records in the PICS (or microfilm) database, and this database will not include the subsequently filed substitute papers.

If the certified copy of an application produced from the PICS (or microfilm) database is illegible, the applicant may pay the fee set forth in 37 CFR 1.19(b)(2) and request that the USPTO obtain the application file and produce a certified copy of the application by photocopying the application-as-filed as contained in the application file. The special handling required to produce a certified copy of the application from the papers in the application file will also cause a delay in when a certified copy is available.

### USE OF METRIC SYSTEM OF MEASUREMENTS IN PATENT APPLICATIONS

In order to minimize the necessity in the future for converting dimensions given in the English system of measurements to the metric system of measurements when using printed patents as research and prior art search documents, all patent applicants should use the metric (S.I.) units followed by the equivalent English units when describing their inventions in the specifications of patent applications.

The initials S.I. stand for "Le Système International d' Unités," the French name for the International System of Units, a modernized metric system adopted in 1960 by the International General Conference of Weights and Measures based on precise unit measurements made possible by modern technology.

**FILING OF NON-ENGLISH LANGUAGE APPLICATIONS**

*37 CFR 1.52. Language, Paper, Writing, Margins, Compact Disc Specifications.*

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(d) A nonprovisional or provisional application may be in a language other than English.

(1) Nonprovisional application. If a nonprovisional application is filed in a language other than English, an English language translation of the non-English language application, a statement that the translation is accurate, and the processing fee set forth in § 1.17(i) are required. If these items are not filed with the application, applicant will be notified and given a period of time within which they must be filed in order to avoid abandonment.

(2) Provisional application. If a provisional application is filed in a language other than English, an English language translation of the non-English language provisional application will not be required in the provisional application. See § 1.78(a) for the requirements for claiming the benefit of such provisional application in a nonprovisional application.

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The U.S. Patent and Trademark Office will accord a filing date to an application meeting the requirements of 35 U.S.C. 111(a), or a provisional application in accordance with 35 U.S.C. 111(b), even though some or all of the application papers, including the written description and the claims, is in a language other than English and hence does not comply with 37 CFR 1.52.

An English translation of the non-English language papers, a statement that the translation is accurate, the filing fee, the oath or declaration (if necessary) and fee set forth in 37 CFR 1.17(i) should either accompany the nonprovisional application papers or be filed in the Office within the time set by the Office. If a provisional application is filed in a language other than English, an English translation of the non-English language provisional application will not be required in the provisional application. Rather, the English translation of the non-English language provisional application and a statement that the translation is accurate must be submitted in any nonprovisional application claiming benefit of the non-English language provisional application (see 37 CFR 1.78(a)(5)).

A subsequently filed English translation must contain the complete identifying data for the application

in order to permit prompt association with the papers initially filed. Accordingly, it is strongly recommended that the original application papers be accompanied by a cover letter and a self-addressed return postcard, each containing the following identifying data in English: (a) applicant's name(s); (b) title of invention; (c) number of pages of specification, claims, and sheets of drawings; (d) whether oath or declaration was filed and (e) amount and manner of paying the filing fee.

The translation must be a literal translation and must be accompanied by a statement that the translation is accurate. The translation must also be accompanied by a signed request from the applicant, his or her attorney or agent, asking that the English translation be used as the copy for examination purposes in the Office. If the English translation does not conform to idiomatic English and United States practice, it should be accompanied by a preliminary amendment making the necessary changes without the introduction of new matter prohibited by 35 U.S.C. 132. In the event the English translation is not timely filed in the Office, the application will be regarded as abandoned.

It should be recognized that this practice is intended for emergency situations to prevent loss of valuable rights and should not be routinely used for filing applications. There are at least two reasons why this should not be used on a routine basis. First, there are obvious dangers to applicant and the public if he or she fails to obtain a correct literal translation. Second, the filing of a large number of applications under the procedure will create significant administrative burdens on the Office.

**ILLUSTRATIONS IN THE SPECIFICATION**

Graphical illustrations, diagrammatic views, flowcharts, and diagrams in the descriptive portion of the specification do not come within the purview of 37 CFR 1.58(a), which permits tables, chemical and mathematical formulas in the specification in lieu of formal drawings. The examiner should object to such descriptive illustrations in the specification and request formal drawings in accordance with 37 CFR 1.81 when an application contains graphs in the specification.

The specification, including any claims, may contain chemical formulas and mathematical equations, but may not contain drawings or flow diagrams. The

description portion of the specification may contain tables; claims may contain tables only if necessary to conform to 35 U.S.C. 112.

See MPEP § 601.01(d) for treatment of applications filed without all pages of the specification.

### Hyperlinks and Other Forms of Browser-Executable Code in the Specification

Examiners must review patent applications to make certain that hyperlinks and other forms of browser-executable code, especially commercial site URLs, are not included in a patent application. Examples of a hyperlink or a browser-executable code are a URL placed between these symbols "<>" and http:// followed by a URL address. When a patent application with embedded hyperlinks and/or other forms of browser-executable code issues as a patent (or is published as a patent application publication) and the patent document is placed on the USPTO web page, when the patent document is retrieved and viewed via a web browser, the URL is interpreted as a valid HTML code and it becomes a live web link. When a user clicks on the link with a mouse, the user will be transferred to another web page identified by the URL, if it exists, which could be a commercial web site. USPTO policy does not permit the USPTO to link to any commercial sites since the USPTO exercises no control over the organization, views or accuracy of the information contained on these outside sites.

If hyperlinks and/or other forms of browser-executable code are embedded in the text of the patent application, examiners should object to the specification and indicate to applicants that the embedded hyperlinks and/or other forms of browser-executable code are impermissible and require deletion. This requirement does not apply to electronic documents listed on forms PTO-892 and PTO-1449 where the electronic document is identified by reference to a URL.

The attempt to incorporate subject matter into the patent application by reference to a hyperlink and/or other forms of browser-executable code is considered to be an improper incorporation by reference. See MPEP § 608.01(p), paragraph I regarding incorporation by reference. Where the hyperlinks and/or other forms of browser-executable codes are part of applicant's invention and it is necessary to have them included in the patent application in order to comply with the requirements of 35 U.S.C. 112, first para-

graph, and applicant does not intend to have these hyperlinks be active links, examiners should not object to these hyperlinks. The Office will disable these hyperlinks when preparing the text to be loaded onto the USPTO web database.

Note that nucleotide and/or amino acid sequence data placed between the symbols "<>" are not considered to be hyperlinks and/or browser-executable code and therefore should not be objected to as being an improper incorporation by reference (see 37 CFR 1.821 – 1.825).

#### *¶ 7.29.04 Disclosure Objected To, Embedded Hyperlinks or Other Forms of Browser-Executable Code*

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

#### Examiner Note:

1. Examples of a hyperlink or a browser-executable code are a URL placed between these symbols "<>" and http:// followed by a URL address. Nucleotide and/or amino acid sequence data placed between the symbols "<>" are not considered to be hyperlinks and/or browser-executable code.
2. If the application attempts to incorporate essential subject matter into the patent application by reference to a hyperlink and/or other form of browser-executable code, see MPEP § 608.01.
3. The requirement to delete an embedded hyperlink or other form of browser-executable code does not apply to electronic documents listed on forms PTO-892 and PTO-1449 where the electronic document is identified by reference to a URL.

### 608.01(a) Arrangement of Application

#### *37 CFR 1.77. Arrangement of application elements.*

(a) The elements of the application, if applicable, should appear in the following order:

- (1) Utility application transmittal form.
- (2) Fee transmittal form.
- (3) Application data sheet (see § 1.76).
- (4) Specification.
- (5) Drawings.
- (6) Executed oath or declaration.

(b) The specification should include the following sections in order:

- (1) Title of the invention, which may be accompanied by an introductory portion stating the name, citizenship, and residence of the applicant (unless included in the application data sheet).
- (2) Cross-reference to related applications (unless included in the application data sheet).
- (3) Statement regarding federally sponsored research or development.
- (4) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on a compact disc and an incorporation-by-reference of the material on the compact disc

(see § 1.52(e)(5)). The total number of compact discs including duplicates and the files on each compact disc shall be specified.

- (5) Background of the invention.
- (6) Brief summary of the invention.
- (7) Brief description of the several views of the drawing.
- (8) Detailed description of the invention.
- (9) A claim or claims.
- (10) Abstract of the disclosure.
- (11) "Sequence Listing," if on paper (see §§ 1.821 through 1.825).

(c) The text of the specification sections defined in paragraphs (b)(1) through (b)(11) of this section, if applicable, should be preceded by a section heading in uppercase and without underlining or bold type.

For design patent specification, see MPEP § 1503.01.

For plant patent specification, see MPEP § 1605.

For reissue patent specification, see MPEP § 1411.

The following order of arrangement of specification elements is preferable in framing the nonprovisional specification and, except for the drawings, each of the lettered items should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading. It is recommended that provisional applications follow the same general format, although claims are not required. If an application data sheet (37 CFR 1.76) is used, data supplied in the application data sheet need not be provided elsewhere in the application except that the citizenship of each inventor must be provided in the oath or declaration under 37 CFR 1.63 even if this information is provided in the application data sheet (see 37 CFR 1.176(b)). If there is a discrepancy between the information submitted in an application data sheet and the information submitted elsewhere in the application, the application data sheet will control except for the naming of the inventors and the citizenship of the inventors. See MPEP § 601.05.

- (A) Title of the Invention.
- (B) Cross-References to Related Applications.
- (C) Statement Regarding Federally Sponsored Research or Development.
- (D) Reference to a "Sequential Listing," a table, or a computer program listing appendix submitted on a compact disc (See 37 CFR 1.52(e)(5)).
- (E) Background of the Invention.
  - (1) Field of the Invention.

(2) Description of the related art including information disclosed under 37 CFR 1.97 and 1.98.

(F) Brief Summary of the Invention.

(G) Brief Description of the Several Views of the Drawings.

(H) Detailed Description of the Invention.

(I) Claim or Claims.

(J) Abstract of the Disclosure.

(K) Drawings.

(L) "Sequence Listing," if on paper (See 37 CFR 1.821-1.825).

Applicant (typically a *pro se*) may be advised of the proper arrangement by using Form Paragraph 6.01 or 6.02.

#### *¶ 6.01 Arrangement of Specification*

The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

The following order or arrangement is preferred in framing the specification and, except for the reference to the drawings, each of the lettered items should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-Reference to Related Applications.
- (c) Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on a compact disc (see 37 CFR 1.52(e)(5)).
- (e) Background of the Invention.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.
- (i) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing, if on paper (see 37 CFR 1.821-1.825).

#### **Examiner Note:**

In this paragraph an introductory sentence will be necessary. This paragraph is intended primarily for use in *pro se* applications.

#### *¶ 6.02 Content of Specification*

#### **Content of Specification**

reference which may not be readily available. Through the Office's incorporation by reference policy, the Office ensures that reasonably complete disclosures are published as U.S. patents. The same policy concern does not apply where the sole purpose for which an applicant relies on an earlier U.S. or foreign application is to establish an earlier filing date. Incorporation by reference in the earlier application of (1) patents or applications published by foreign countries or regional patent offices, (2) nonpatent publications, (3) a U.S. patent or application which itself incorporates "essential material" by reference, or (4) a foreign application, is not critical in the case of a "benefit" application.

When an applicant, or a patent owner in a reexamination or interference, claims the benefit of the filing date of an earlier application which incorporates material by reference, the applicant or patent owner may be required to supply copies of the material incorporated by reference. For example, an applicant may claim the benefit of the filing date of a foreign application which itself incorporates by reference another earlier filed foreign application. If necessary, due to an intervening reference, applicant should be required to supply a copy of the earlier filed foreign application, along with an English language translation. A review can then be made of the foreign application and all material incorporated by reference to determine whether the foreign application discloses the invention sought to be patented in the manner required by the first paragraph of 35 U.S.C. 112 so that benefit may be accorded. *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989).

## II. SIMULATED OR PREDICTED TEST RESULTS OR PROPHETIC EXAMPLES

Simulated or predicted test results and prophetical examples (paper examples) are permitted in patent applications. Working examples correspond to work actually performed and may describe tests which have actually been conducted and results that were achieved. Paper examples describe the manner and process of making an embodiment of the invention which has not actually been conducted. Paper examples should not be represented as work actually done. No results should be represented as actual results unless they have actually been achieved. Paper examples should not be described using the past tense.

For problems arising from the designation of materials by trademarks and trade names, see MPEP § 608.01(v).

## 608.01(q) Substitute or Rewritten Specification

### 37 CFR 1.125. Substitute specification.

(a) If the number or nature of the amendments or the legibility of the application papers renders it difficult to consider the application, or to arrange the papers for printing or copying, the Office may require the entire specification, including the claims, or any part thereof, be rewritten.

(b) A substitute specification, excluding the claims, may be filed at any point up to payment of the issue fee if it is accompanied by:

(1) A statement that the substitute specification includes no new matter; and

(2) A marked up version of the substitute specification showing all the changes (including the matter being added to and the matter being deleted from) to the specification of record. Numbering the paragraphs of the specification of record is not considered a change that must be shown pursuant to this paragraph.

(c) A substitute specification submitted under this section must be submitted in clean form without markings as to amended material. The paragraphs of any substitute specification, other than the claims, should be individually numbered in Arabic numerals so that any amendment to the specification may be made by replacement paragraph in accordance with § 1.121(b)(1).

(d) A substitute specification under this section is not permitted in a reissue application or in a reexamination proceeding.

The specification is sometimes in such faulty English that a new specification is necessary; in such instances, a new specification should be required.

Form paragraph 6.28 may be used where the specification is in faulty English.

### ¶ 6.28 Idiomatic English

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

37 CFR 1.125(a) applies to a substitute specification required by the Office. If the number or nature of the amendments or the legibility of the application papers renders it difficult to consider the application, or to arrange the papers for printing or copying, the Office may require the entire specification, including the claims, or any part thereof be rewritten.

Form paragraph 6.28.01 may be used where the examiner, for reasons other than faulty English, requires a substitute specification.

**¶ 6.28.01 Substitute Specification Required by Examiner**

A substitute specification [1] the claims is required pursuant to 37 CFR 1.125(a) because [2].

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

**Examiner Note:**

1. In bracket 1, insert either -- excluding-- or -- including--.
2. In bracket 2, insert clear and concise examples of why a new specification is required.
3. A new specification is required if the number or nature of the amendments render it difficult to consider the application or to arrange the papers for printing or copying, 37 CFR 1.125.
4. See also form paragraph 13.01 for partial rewritten specification.
5. 37 CFR 1.125(b) provides applicants with the right of entry of substitute specifications, under the conditions set forth in the section, in applications other than reissue applications (37 CFR 1.125(d)) that have not been required by the examiner.

37 CFR 1.125(b) applies to a substitute specification voluntarily filed by the applicant. A substitute specification, excluding claims, may be voluntarily filed by the applicant at any point up to the payment of the issue fee provided it is accompanied by (1) a statement that the substitute specification includes no new matter, and (2) a marked-up copy of the substitute specification showing the matter being added to and the matter being deleted from the specification of record. Numbering the paragraphs of the specification of record is not considered a change that must be shown under 37 CFR 1.125(b)(2). 37 CFR 1.125(b). The Office will accept a substitute specification voluntarily filed by the applicant if the requirements of 37 CFR 1.125(b) are satisfied.

37 CFR 1.125(c) requires a substitute specification filed under 37 CFR 1.125(a) or (b) be submitted in clean form without markings as to amended material. The paragraphs of any substitute specification, other than the claims, should be individually numbered in

Arabic numerals so that any amendment to the specification may be made by replacement paragraph in accordance with 37 CFR 1.121(b)(1).

A substitute specification filed under 37 CFR 1.125(b) must be accompanied by a statement indicating that no new matter was included. There is no obligation on the examiner to make a detailed comparison between the old and the new specifications for determining whether or not new matter has been added. If, however, an examiner becomes aware that new matter is present, objection thereto should be made.

The filing of a substitute specification rather than amending the original application has the advantage for applicants of eliminating the need to prepare an amendment of the specification. If word processing equipment is used by applicants, substitute specifications can be easily prepared. The Office receives the advantage of saving the time needed to enter amendments in the specification and a reduction in the number of printing errors. A substitute specification is not permitted in a reissue application or in a reexamination proceeding. 37 CFR 1.125(d).

A substitute specification which complies with 37 CFR 1.125 should normally be entered. The examiner should write "Enter" or "OK to Enter" and his or her initials in ink in the left margin of the first page of the substitute specification. A substitute specification which is denied entry should be so marked.

Form paragraph 6.28.02 may be used to notify applicant that a substitute specification submitted under 37 CFR 1.125(b) has not been entered.

**¶ 6.28.02 Substitute Specification Filed Under 37 CFR 1.125(b) Not Entered.**

The substitute specification filed [1] has not been entered because it does not conform to 37 CFR 1.125(b) because: [2]

**Examiner Note:**

1. In bracket 2, insert statement of why the substitute specification is improper, for example:
  - the statement as to a lack of new matter under 37 CFR 1.125(b) is missing--;
  - a marked-up copy of the substitute specification has not been supplied (in addition to the clean copy)--;
  - a clean copy of the substitute specification has not been supplied (in addition to the marked-up copy)--; or,
  - the substitute specification has been filed:
    - in a reissue application or in a reexamination proceeding, 37 CFR 1.125(d)-, or
    - after payment of the issue fee-, or
    - containing claims (to be amended)--.

See MPEP § 714.20 regarding entry of amendments which include an unacceptable substitute specification.

For new matter in amendment, see MPEP § 608.04.

For application prepared for issue, see MPEP § 1302.02.

### **608.01(r) Derogatory Remarks About Prior Art in Specification**

The applicant may refer to the general state of the art and the advance thereover made by his or her invention, but he or she is not permitted to make derogatory remarks concerning the inventions of others. Derogatory remarks are statements disparaging the products or processes of any particular person other than the applicant, or statements as to the merits or validity of applications or patents of another person. Mere comparisons with the prior art are not considered to be disparaging, *per se*.

### **608.01(s) Restoration of Canceled Matter**

Canceled text in the specification can be reinstated only by a subsequent amendment presenting the previously canceled matter as a new insertion. 37 CFR 1.121(b)(4). A claim canceled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number. 37 CFR 1.121(c)(2). See MPEP § 714.24.

### **608.01(t) Use in Subsequent Application**

A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application. 37 CFR 1.79; MPEP § 608.01(e).

No part of a specification can normally be transferred to another application. Drawings may be transferred to another application only upon the granting of a petition filed under the provisions of 37 CFR 1.182. See MPEP § 608.02(i).

### **608.01(u) Use of Formerly Filed Incomplete Application**

Parts of an incomplete application which have been retained by the Office may be used as part of a complete application if the missing parts are later supplied. See MPEP § 506 and § 506.01.

## **608.01(v) Trademarks and Names Used in Trade**

The expressions "trademarks" and "names used in trade" as used below have the following meanings:

*Trademark:* a word, letter, symbol, or device adopted by one manufacturer or merchant and used to identify and distinguish his or her product from those of others. It is a proprietary word, letter, symbol, or device pointing distinctly to the product of one producer.

*Names Used in Trade:* a nonproprietary name by which an article or product is known and called among traders or workers in the art, although it may not be so known by the public, generally. Names used in trade do not point to the product of one producer, but they identify a single article or product irrespective of producer.

Names used in trade are permissible in patent applications if:

(A) Their meanings are established by an accompanying definition which is sufficiently precise and definite to be made a part of a claim, or

(B) In this country, their meanings are well-known and satisfactorily defined in the literature.

Condition (A) or (B) must be met at the time of filing of the complete application.

## **TRADEMARKS**

The relationship between a trademark and the product it identifies is sometimes indefinite, uncertain, and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. In patent specifications, every element or ingredient of the product should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to mean different things at the pleasure of manufacturers do not constitute such language. *Ex Parte Kattwinkle*, 12 USPQ 11 (Bd. App. 1931).

However, if the product to which the trademark refers is set forth in such language that its identity is clear, the examiners are authorized to permit the use of the trademark if it is distinguished from common descriptive nouns by capitalization. If the trademark has a fixed and definite meaning, it constitutes

## MANUAL OF PATENT EXAMINING PROCEDURE

sufficient identification unless some physical or chemical characteristic of the article or material is involved in the invention. In that event, as also in those cases where the trademark has no fixed and definite meaning, identification by scientific or other explanatory language is necessary. *In re Gebauer-Fuelnegg*, 121 F.2d 505, 50 USPQ 125 (CCPA 1941).

The matter of sufficiency of disclosure must be decided on an individual case-by-case basis. *In re Metcalfe*, 410 F.2d 1378, 161 USPQ 789 (CCPA 1969).

Where the identification of a trademark is introduced by amendment, it must be restricted to the characteristics of the product known at the time the application was filed to avoid any question of new matter.

If proper identification of the product sold under a trademark, or a product referred to only by a name used in trade, is omitted from the specification and such identification is deemed necessary under the principles set forth above, the examiner should hold the disclosure insufficient and reject on the ground of insufficient disclosure any claims based on the identification of the product merely by trademark or by the name used in trade. If the product cannot be otherwise defined, an amendment defining the process of its manufacture may be permitted. Such amendments must be supported by satisfactory showings establishing that the specific nature or process of manufacture of the product as set forth in the amendment was known at the time of filing of the application.

Although the use of trademarks having definite meanings is permissible in patent applications, the proprietary nature of the marks should be respected. Trademarks should be identified by capitalizing each letter of the mark (in the case of word or letter marks) or otherwise indicating the description of the mark (in the case of marks in the form of a symbol or device or other nontextual form). Every effort should be made to prevent their use in any manner which might adversely affect their validity as trademarks.

Form paragraph 6.20 may be used.

#### *¶ 6.20 Trademarks and Their Use*

The use of the trademark [1] has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected

and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

#### **Examiner Note:**

Capitalize each letter of the word in the bracket or include a proper trademark symbol, such as™ or ® following the word.

The examiner should not permit the use of language such as "the product X (a descriptive name) commonly known as Y (trademark)" since such language does not bring out the fact that the latter is a trademark. Language such as "the product X (a descriptive name) sold under the trademark Y" is permissible.

The use of a trademark in the title of an application should be avoided as well as the use of a trademark coupled with the word "type", e.g., "Band-Aid type bandage."

In the event that the proprietary trademark is a "symbol or device" depicted in a drawing, either the brief description of the drawing or the detailed description of the drawing should specify that the "symbol or device" is a registered trademark of Company X.

The owner of a trademark may be identified in the specification.

Technology Center Directors should reply to all trademark misuse complaint letters and forward a copy to the editor of this manual.

See Appendix I for a partial listing of trademarks and the particular goods to which they apply.

#### **INCLUSION OF COPYRIGHT OR MASK WORK NOTICE IN PATENTS**

*37 CFR 1.71. Detailed description and specification of the invention*

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(d) A copyright or mask work notice may be placed in a design or utility patent application adjacent to copyright and mask work material contained therein. The notice may appear at any appropriate portion of the patent application disclosure. For notices in drawings, see § 1.84(s). The content of the notice must be limited to only those elements provided for by law. For example, "©1983 John Doe" (17 U.S.C. 401) and "\*M\* John Doe" (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in paragraph (e) of this section is included at the beginning (preferably as the first paragraph) of the specification.

(e) The authorization shall read as follows:

### 713.06 No *Inter Partes* Questions Discussed *Ex Parte*

The examiner may not discuss *inter partes* questions *ex parte* with any of the interested parties.

### 713.07 Exposure of Other Cases

Prior to an interview in the examiner's room, the examiner should arrange his or her desk so that all files, drawings and other papers, except those necessary in the interview, are placed out of view. See MPEP § 101.

### 713.08 Demonstration, Exhibits, Models

The invention in question may be exhibited or demonstrated during the interview by a model thereof. A model received by the examiner from the applicant or his or her attorney which complies with 37 CFR 1.91 and which is made part of the application record must be properly recorded on the "Contents" portion of the application file wrapper. See MPEP § 608.03 and § 608.03(a).

Oftentimes a model or exhibit is not given into the custody of the Office but is brought directly into the group by the attorney solely for inspection or demonstration during the course of the interview. This is permissible. If the model or exhibit is merely used for demonstration purpose and is not made part of the record (does not comply with 37 CFR 1.91), a full description as to what was demonstrated/exhibited must be made of record in the application. See 37 CFR 1.133(b). Demonstrations of apparatus or exhibits too large to be brought into the Office may be viewed by the examiner outside of the Office (in the Washington, D.C. area) with the approval of the supervisory patent examiner. It is presumed that the witnessing of the demonstration or the reviewing of the exhibit is actually essential in the developing and clarifying of the issues involved in the application.

### 713.09 Finally Rejected Application

Normally, one interview after final rejection is permitted. However, prior to the interview, the intended purpose and content of the interview should be presented briefly, preferably in writing. Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accom-

plished with only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations which would require more than nominal reconsideration or new search should be denied. See MPEP § 714.13.

Interviews may be held after the expiration of the shortened statutory period and prior to the maximum permitted statutory period of 6 months without an extension of time. See MPEP § 706.07(f).

A second or further interview after a final rejection may be held if the examiner is convinced that it will expedite the issues for appeal or disposal of the application.

### 713.10 Interview Preceding Filing Amendment Under 37 CFR 1.312

After an application is sent to issue, it is technically no longer under the jurisdiction of the primary examiner. 37 CFR 1.312. An interview with an examiner that would involve a detailed consideration of claims sought to be entered and perhaps entailing a discussion of the prior art for determining whether or not the claims are allowable should not be given. Obviously an applicant is not entitled to a greater degree of consideration in an amendment presented informally than is given an applicant in the consideration of an amendment when formally presented, particularly since consideration of an amendment filed under 37 CFR 1.312 cannot be demanded as a matter of right.

Requests for interviews on cases where a notice of allowance has been mailed should be granted only with specific approval of the Technology Center Director upon a showing in writing of extraordinary circumstances.

## 714 Amendments, Applicant's Action

### 37 CFR 1.121. Manner of making amendments in application.

(a) *Amendments in applications, other than reissue applications.* Amendments in applications, other than reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(b) *Specification other than the claims and listings provided for elsewhere (§§ 1.96 and 1.825).*—

(1) *Amendment by instruction to delete, replace, or add a paragraph.* Amendments to the specification, other than the

## MANUAL OF PATENT EXAMINING PROCEDURE

claims and listings provided for elsewhere (§§ 1.96 and 1.825), may be made by submitting:

(i) An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a deleted paragraph with one or more replacement paragraphs, or add one or more paragraphs;

(ii) Any replacement or added paragraph(s) in clean form, that is, without markings to indicate the changes that have been made; and

(iii) Another version of any replacement paragraph(s), on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of the paragraph(s). The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added paragraph or a deleted paragraph as it is sufficient to state that a particular paragraph has been added, or deleted.

(2) *Amendment by replacement section.* If the sections of the specification contain section headings as provided in §§ 1.77(b), 1.154(b), or § 1.163(c), amendments to the specification, other than the claims, may be made by submitting:

(i) A reference to the section heading along with an instruction to delete that section of the specification and to replace such deleted section with a replacement section;

(ii) A replacement section in clean form, that is, without markings to indicate the changes that have been made; and

(iii) Another version of the replacement section, on one or more pages separate from the amendment, marked up to show all changes relative to the previous version of the section. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system.

(3) *Amendment by substitute specification.* The specification, other than the claims, may also be amended by submitting:

(i) An instruction to replace the specification;

(ii) A substitute specification in compliance with § 1.125(b); and

(iii) Another version of the substitute specification, separate from the substitute specification, marked up to show all changes relative to the previous version of the specification. The changes may be shown by brackets (for deleted matter), or underlining (for added matter), or by any equivalent marking system.

(4) *Reinstatement:* Deleted matter may be reinstated only by a subsequent amendment presenting the previously deleted matter.

(c) *Claims.* —

(1) *Amendment by rewriting, directions to cancel or add.* Amendments to a claim must be made by rewriting such claim with all changes (e.g., additions, deletions, modifications) included. The rewriting of a claim (with the same number) will be construed as directing the cancellation of the previous version of that claim. A claim may also be canceled by an instruction.

(i) A rewritten or newly added claim must be in clean form, that is, without markings to indicate the changes that have been made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added (e.g., "amended," "twice amended," or "new").

(ii) If a claim is amended by rewriting such claim with the same number, the amendment must be accompanied by another version of the rewritten claim, on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of that claim. A parenthetical expression should follow the claim number indicating the status of the claim, e.g., "amended," "twice amended," etc. The parenthetical expression "amended," "twice amended," etc. should be the same for both the clean version of the claim under paragraph (c)(1)(i) of this section and the marked up version under this paragraph. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added claim or a canceled claim as it is sufficient to state that a particular claim has been added, or canceled.

(2) A claim canceled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

(3) A clean version of the entire set of pending claims may be submitted in a single amendment paper. Such a submission shall be construed as directing the cancellation of all previous versions of any pending claims. A marked up version is required only for claims being changed by the current amendment (see paragraph (c)(1)(ii) of this section). Any claim not accompanied by a marked up version will constitute an assertion that it has not been changed relative to the immediate prior version.

(d) *Drawings.* Application drawings are amended in the following manner: Any change to the application drawings must be submitted on a separate paper showing the proposed changes intended for approval by the examiner. Upon approval by the examiner, new drawings in compliance with § 1.84 including the changes must be filed.

(e) *Disclosure consistency.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(f) *No new matter.* No amendment may introduce new matter into the disclosure of an application.

(g) *Exception for examiner's amendments:* Changes to the specification, including the claims, of an application made by the Office in an examiner's amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner's amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. Compliance with paragraphs (b)(1), (b)(2) or (c)(1) of this section is not required.

(h) *Amendments in reissue applications.* Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

(i) *Amendments in reexamination proceedings:* Any proposed amendment to the description and claims in patents involved in reexamination proceedings in both *ex parte* reexaminations filed under § 1.510 and *inter partes* reexaminations filed under § 1.913 must be made in accordance with § 1.530(d)-(j).

(j) *Amendments in provisional applications:* Amendments in provisional applications are not normally made. If an amendment is made to a provisional application, however, it must comply with the provisions of this section. Any amendments to a provisional application shall be placed in the provisional application file but may not be entered.

## WHEN APPLICANT MAY AMEND

The applicant may amend:

(A) before or after the first examination and action and also after the second or subsequent examination or reconsideration as specified in 37 CFR 1.112;

(B) after final rejection, if the amendment meets the criteria of 37 CFR 1.116; and

(C) when and as specifically required by the examiner.

Amendments in provisional applications are not normally made. If an amendment is made to a provisional application, however, it must comply with the provisions of 37 CFR 1.121. Any amendments to a provisional application will be placed in the provisional application file, but may not be entered.

## MANNER OF MAKING AMENDMENTS

After March 1, 2001, all amendments to the specification, including the claims, must be made by replacement paragraph/section/claim in clean form (without underlining and bracketing) in order to eliminate (1) the need for the Office to enter changes to the text of application portions by handwriting in red ink, and (2) the presence of hard to scan brackets and underlining to improve the patent publishing process. This practice requires the applicant to provide a clean copy of an amended paragraph/section/claim together with a marked up version using applicant's choice of a marking system showing the changes being made which will aid the examiner. The marked up version must be based on the immediate previous version and indicate (by markings) how the previous version has been modified to produce the clean replacement paragraph(s), section(s), specification or claim(s) submitted in the current amendment. "Previous version" is defined as the version of record in the application as originally filed or from a previously entered amendment.

### *Amendments to the Specification*

In order to delete, replace or add a paragraph to the specification of an application, the amendment must unambiguously identify the paragraph to be modified either by paragraph number (see MPEP § 608.01), page and line, or any other unambiguous method and be accompanied by the replacement paragraph(s) in clean form.

Where paragraph numbering has been included in an application as provided in 37 CFR 1.52(b)(6), applicants can easily refer to a specific paragraph by number when presenting an amendment. If a numbered paragraph is to be replaced by a single paragraph, the added replacement paragraph should be numbered with the same number of the paragraph being replaced. Where more than one paragraph is to replace a single original paragraph, the added paragraphs should be numbered using the number of the original paragraph for the first replacement paragraph, followed by increasing decimal numbers for the second and subsequent added paragraphs, e.g., original paragraph [0071] has been replaced with paragraphs [0071], [0071.1], and [0071.2]. If a numbered paragraph is deleted, the numbering of the subsequent paragraphs should remain unchanged.

37 CFR 1.121(b)(1)(ii) requires that the replacement or added paragraph(s) be in clean form. This means that the added or replacement paragraph(s) must not include any markings to indicate the changes that have been made. 37 CFR 1.121(b)(1)(iii) requires that a separate version of the replacement paragraph(s) accompany the amendment. The separate version must include each replacement paragraph with markings to show the changes relative to the previous version as an aid to the examiner. A marked up version, however, does not have to be supplied for any added paragraph(s) or any deleted paragraph(s), as it is sufficient to merely indicate or identify any paragraph that has been added or deleted.

Applicants are also permitted to amend the specification by replacement sections (e.g., as provided in 37 CFR 1.77(b), 1.154(b), or 1.163(c)). As with replacement paragraphs, the amended version of a replacement section is required to be provided in clean form, that is, without any markings to show the changes that have been made. A separate marked up version showing the changes in the section relative to the previous

version must accompany the actual amendment as an aid to the examiner.

Applicants are also permitted to amend the specification by submitting a substitute specification, provided the requirements of 37 CFR 1.125(b) are met. An accompanying separate marked up version showing the changes in the specification relative to the previous version is also required.

Any subject matter deleted by amendment can only be reinstated by a subsequent amendment presenting the previously deleted subject matter. A direction by applicant to remove a previously entered amendment will not be permitted.

#### *Amendments to the Claims*

All amendments to a claim must be presented in the form of a rewritten claim. Any rewriting of a claim will be construed as a direction to cancel the previous version of the claim. See *In re Byers*, 230 F.2d 451, 455, 109 USPQ 53, 55 (CCPA 1956)(amendment of a claim by inclusion of an additional limitation had exactly the same effect as if the claim as originally presented had been canceled and replaced by a new claim including that limitation). Any rewritten or newly added claim must be submitted in clean form, that is, with no markings to indicate the changes that have been made, and must be accompanied by a marked up version separate from the amendment using applicant's choice of marking system to indicate the changes being made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added, e.g., "amended," "twice amended," or "new," in both the clean version and the marked up version. A marked up version does not have to be supplied for any added claims or any canceled claims. If a marked up version is supplied to show changes made to amended claims, however, applicant should identify (in the marked up version) any added or canceled claims with a statement, such as, "Claim 6 has been canceled." A canceled claim can be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

Applicants may submit a clean version (with no markings) of all of the pending claims in one amendment paper. Applicants may wish to consolidate all previous versions of pending claims from a series of

separate amendment papers into a single clean version in a single amendment paper. Providing this consolidation of claims in the file will be beneficial to both the Office and the applicant for patent printing purposes. When rewriting a claim in the clean set, the parenthetical expression, if any, from the claim to be rewritten should not appear in the clean set. Thus, the only time a parenthetical expression should appear in the clean set is when a claim is being amended. See MPEP § 714.13 for submitting a clean set of claims under 37 CFR 1.116 and MPEP § 714.16 for submitting a clean set under 37 CFR 1.312. See also MPEP § 714.22(a).

It is recommended that the following format be used by applicants in complying with the revised amendment practice requirements. The amendment paper should include, in the following order:

- (A) a clean version of the amended (replacement) paragraph(s)/claim(s);
- (B) a remarks section (beginning on a separate sheet); and
- (C) a marked-up version (also beginning on a separate sheet) showing changes and clearly identified as "Version with markings to show changes made."

The submission of a clean version of all pending claims shall be construed as directing the cancellation of all previous versions of any pending claims. A marked up version would only be needed for claims being changed by the current amendment (see 37 CFR 1.121(c)(1)(ii)). Any claim not accompanied by a marked up version will constitute an assertion that it has not been modified relative to the immediate prior version. Thus, if applicant is not making any amendments to the claims, but is merely presenting all pending claims in clean form, without any underlining and bracketing, a marked up version should not be submitted.

37 CFR 1.121(g) permits the Office to make amendments to the specification, including the claims, by examiner's amendments without paragraph/section/claim replacement in the interest of expediting prosecution and reducing cycle time. Additions or deletions of subject matter in the specification, including the claims, may be made by instructions to make the change at a precise location in the specification or the claims. See MPEP § 1302.04.